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IN THE

Supreme Court of the United States

OCTOBER TERM, 1947

No. 488

OSTBY AND BARTON COMPANY and AMERICAN ASSOCIATES, INC.,

Petitioners,

v.

THOGER GRONBERG JUNGERSEN,

Respondent.

MOTION FOR LEAVE TO FILE PETITION FOR REHEARING OUT OF TIME AND PETITION FOR REHEARING

JOHN VAUGHAN GRONER,
EDWARD WINSOR,
Counsel for Petitioners.

New York, N. Y.
April 14, 1948

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Statute Cited

Judicial Code, as amended (28 U. S. C. A. 348):

Section 240a 7

IN THE

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OCTOBER TERM, 1947

No. 468

OSTBY AND BARTON COMPANY and AMERICAN ASSOCIATES, INC.,

Petitioners,

v.

THOGER GRONBERG JUNGERSEN,

Respondent.

MOTION FOR LEAVE TO FILE PETITION FOR REHEARING OUT OF TIME

TO THE HONORABLE THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioners respectfully request leave, out of time, to file the accompanying petition for rehearing of the petition for a writ of certiorari to the United States Circuit Court of Appeals for the Third Circuit.

In support of this motion, petitioners represent—

(a) That at the present time a direct conflict exists between the decision of the Circuit Court of Appeals for the Third Circuit and the decision of the Circuit Court of Appeals for the Second Circuit, with respect to the validity of claims 1 to 4 of Jungerson patent No. 2,118,468.

This conflict did *not* exist at the time petitioner's petition for certiorari was presented on December 3, 1947 and

denied on January 12, 1948 (332 U. S. 852), or at the time petitioner's motion to extend the time allowed for filing petition for rehearing was denied on February 2, 1948 (U. S. 68 Sup. Ct. 451).

In this action, instituted by petitioners for declaratory judgment, the District Court for the District of New Jersey held claims 1 to 4 of Jungersen patent No. 2,118,468 valid and not infringed and claims 5 and 6 thereof invalid (65 F. Supp. 652). The Circuit Court of Appeals for the Third Circuit, in a *per curiam* opinion, affirmed (163 F. 2d 312).

On March 10, 1948, in the case of *Jungersen* v. *Baden et al.*, the Circuit Court of Appeals for the Second Circuit affirmed the District Court for the Southern District of New York (69 F. Supp. 922), holding the entire Jungersen patent No. 2,118,468 invalid (F. 2d , 76 U. S. P. Q. 488).

There is no conflict with respect to claims 5 and 6 of said patent.

There is direct conflict with respect to claims 1 to 4 of said patent.

(b) The prior filing of petition for certiorari by respondents, the action of this Court in denying said petition and this motion, are all within the same Term of this Court.

WHEREFORE, petitioners pray that this motion allowing petitioners to file the accompanying petition for rehearing of said petition for a writ of certiorari be granted.

Respectfully submitted,

JOHN VAUGHAN GRONER,
EDWARD WINSOR,
Counsel for Petitioners.

New York, N. Y.
April 14, 1948

I hereby certify that in my opinion the foregoing motion and the accompanying petition for rehearing of the petition for a writ of certiorari are well founded in point of law, are presented in good faith and not for delay and that said petition for rehearing of said petition for writ of certiorari is restricted to the grounds therein specified.

JOHN VAUGHAN GRONER,
Of Counsel for Petitioners.

PETITION FOR REHEARING OF THE PETITION FOR WRIT OF CERTIORARI

TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT:

The petition of Ostby and Barton Company and American Associates, Inc. prays the issue of a writ of certiorari to the Circuit Court of Appeals for the Third Circuit to review so much of a decision and order of that court entered September 5, 1947, as holds valid Claims 1 to 4 of United States Letters Patent No. 2,118,468. A transcript of the record, including the proceedings in said Circuit Court of Appeals, has been filed herein pursuant to Rule 38.

Summary and Short Statement of Matters Involved

Action herein was instituted by Ostby and Barton Company for Declaratory Judgment that Jungersen patent No. 2,118,468 was invalid and not infringed (R., pp. 1a-9a). Respondent counterclaimed (R., pp. 9a-16a).* Following hearing, the District Court filed its opinion (R. pp. 22a-32a; 65 F. Supp. 652) and its findings of fact and conclusions of law (R., pp. 32a-39a) holding Claims 1 to 4 of said patent valid but not infringed and Claims 5 and 6 of said patent invalid. Upon appeal by both parties, the Circuit Court of Appeals, in a *per curiam* decision, affirmed the court below "for the reasons stated" in the opinion of the District Court (R., p. 378; 163 F. 2d 312).

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* American Associates, Inc., having acquired the assets of Ostby and Barton Company, subsequently was added as a party plaintiff (R., pp. 33a-39a). Petitioner, Ostby and Barton Company is a successor of the original plaintiff (R., p. 376).

During the pendency of this action in the District Court, respondent instituted action for infringement of the same patent in the District Court of the United States for the Southern District of New York against Baden & Foss, a partnership. Thereafter seven corporations and fifteen individuals, comprising six partnerships, having been threatened by claims of infringement of the Jungersen patent, intervened in the *Baden* case and became defendants therein. The District Court (Judge Simon Rifkind) in April 1947, held that all six claims of the patent in suit were invalid and void (69 F. Supp. 922), and on appeal to the Circuit Court of Appeals for the Second Circuit, that court (L. Hand, Augustus N. Hand and Clark, Circuit Judges), by Judge Clark, affirmed the decision below, Judge Learned Hand dissenting (F. 2d , 76 U. S. P. Q. 488).

Question Presented

Are Claims 1 to 4 of Jungersen patent No. 2,118,468 valid as held below or invalid as held in the *Baden* case?

Reasons Relied Upon for the Allowance of the Writ

1. The decisions herein with respect to Claims 1 to 4 of said patent are in direct conflict with the decision of the Circuit Court of Appeals for the Second Circuit in *Jungersen* v. *Baden, et al* (F. 2d , 76 U. S. P. Q. 488).

2. The decisions herein are in direct conflict with the established rule of law as to equivalence most recently set forth by this Court in *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320, 330.

3. The decisions herein fail to apply the established rule of law most recently stated by this Court in *Bassick Co.* v. *Hollingshead Co.*, 298 U.S. 415 and *Lincoln Co.* v. *Stewart-*

Warner Corp., 303 U. S. 545, that the improvement of a single old step in an old combination does not sanction the repatenting of that old combination.

WHEREFORE, Petitioners pray that this petition for rehearing of their petition for a writ of certiorari to the United States Circuit Court of Appeals for the Third Circuit be granted.

Respectfully submitted,

JOHN VAUGHAN GRONER,
EDWARD WINSOR,
Counsel for Petitioners.

New York, N. Y.
April 14, 1948.

BRIEF IN SUPPORT OF PETITION

Opinions of the Courts Below

The opinion of the District Court (R., pp. 22a-32a) is reported in 65 F. Supp. 652. The opinion of the Circuit Court of Appeals for the Third Circuit (R., p. 378) is reported in 163 F. 2d 312. The order of this Court denying petitioners' petition for writ of certiorari is reported in 332 U. S. 852. Its order denying petitioners' motion to extend time allowed for filing petition for rehearing is reported in U. S. , 68 Sup. Ct. 451.

The opinion of the District Court for the Southern District of New York in *Jungersen* v. *Baden*, involving a record which generally is the equivalent of that here, is reported in 69 F. Supp. 922. The opinion of the Circuit Court of Appeals for the Second Circuit is reported in F. 2d , 76 U. S. P. Q. 488.

Jurisdiction

The grounds of jurisdiction are:

1. The statute under which jurisdiction is invoked is Section 240a of the Judicial Code, as amended (28 U. S. C. A. § 347).

2. Cases wherein petition for rehearing was allowed to be filed out of time and the petition for certiorari granted are: *Schriber Co.* v. *Cleveland Trust Co.*, 304 U. S. 587; *Kellogg Co.* v. *Nat. Biscuit Co.* 304 U. S. 586.

3. Cases believed to sustain the jurisdiction are: *General Electric Co.* v. *Jewel Co.*, 326 U. S. 242; *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320, 322.

Argument

The patent in suit relates to a method of casting. The sequential steps, broadly stated, are (a) the making of a

model, (b) the making of a (primary) elastic mould around the model, (c) the making of wax replicas or patterns in the mould, (d) the formation of a plaster-of-paris-like (secondary) mould, called an "investment", around the patterns, (e) the burning out of the wax leaving a cavity in the secondary mould and (f) the casting of metal into this cavity (R., p. 502a).

These steps, in the sequence shown, are at least as old as Cellini (R., pp. 448a-469a, 499a).

Jungersen's British patent No. 449,062 (R., p. 495a)—the substantial equivalent of the patent in suit—admits this. It says:

> "In the casting of metal it is not broadly new to make an elastic mould from an original sample or model, to produce a wax or fusible pattern with the aid of the elastic mould and to remove the pattern from the latter and invest it in a final mould from which the wax or fusible pattern is subsequently melted out to permit of the pouring of metal into the mould cavity thus vacated" (R., p. 495a, ll. 19-28).

The only improvement even claimed by respondent in his British Patent is found in the means—centrifugal force—employed for casting the molten material into the moulds (R., p. 495a, ll. 38-50).

Claims 1 to 4 relate to all or some of the steps referred to above and all are limited to the centrifugal casting of the wax.

1. The decision of the District Court and of the Court of Appeals in holding Claims 1 to 4 valid is in direct conflict with the rule of *Dow Co.* v. *Halliburton Co.*, 324 U. S. 320. This Court there said (324 U. S. 330):

> "It is elemental that the mere substitution of equivalents which do substantially the same thing in

> the same way, even though better results may be produced, is not such an invention as will sustain a patent."

Kralund patent No. 1,238,789 discloses each step of the Jungersen patent here in issue (R., pp. 413a-416a, 499a). Instead, however, of casting the wax patterns under the pressure of centrifugal force, as taught by Jungersen, Kralund does it under the pressure of a die casting machine (R., pp. 414a, lines 53-61, 70-85). Both a die casting machine and a centrifugal machine were well known means of applying pressure in the casting of molten material long prior to Jungersen (R., pp. 160a-161a, 150a, 413a, 417a, 477a), and that they are pure equivalents is not even contested by Jungersen. The District Court in the *Baden* case so held (69 F. Supp. 926-927). So too, in effect, did the Court of Appeals for the Second Circuit (F. 2d , 76 U. S. P. Q. 490).

Despite this equivalence and in disregard of the rule of the *Dow* case, the District Court here, and the Circuit Court of Appeals in affirming "for the reasons stated" (R., p. 378; 163 F. 2d 312), held that

> "it is no argument for invalidity to assert that the use of centrifugal force is the mere substitution of equivalents which do substantially the same thing" (R., pp. 26a-27a; 65 F. Supp. 652, 656).

The decision below is in square conflict with the established rule. Clearly it decides a federal question in a way irreconcilable with applicable decisions of this Court and of the Circuit Court of Appeals for the Second Circuit.

2. The decision below erred in not applying the rule of *Bassick Co.* v. *Hollingshead Co.*, 298 U. S. 415 and *Lincoln Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545.

The District Court here mistakenly conceived the step of casting the wax by the use of centrifugal force, to be a

"new step" or an *"additional step"* in the practice of the process of the patent (R., p. 25a; 65 F. Supp. 655) and that the patent itself was directed to "a combination of old elements, *to which a new element has been added"* (R., p. 26a; 65 F. Supp. 655). In fact, it was simply an old process wherein at one old step particular means were used to do identically what had been done before by other means. Illustratively, Cellini (R., p. 448a), Spencer (R., p. 400a), Haseltine (R., p. 427a), LaGravure (R. p. 469a), and Kralund (R., p. 413a) practiced every step disclosed in the Jungersen patent. Instead, however, of casting their wax patterns by centrifugal force, Cellini, Spencer, Haseltine and LaGravure cast the wax by gravity, and Kralund by a pressure die casting machine (R., p. 149a).

On this score, the Court of Appeals in the *Baden* case said (F. 2d , 76 U. S. P. Q. 491):

> "The judge in the Ostby & Barton case referred to the use of centrifugal force as an 'additional step' in the art which was both 'new' and 'novel'. We are forced to disagree. It could hardly be an additional step; at most it can be only a modification or a different execution of an existing step."

But, having fallen into this error, the District Court and the Court of Appeals in this case made the further error of not applying the doctrine of the *Bassick* and the *Lincoln* cases.

In the *Bassick* case, the patentee improved one element in an old combination, but instead of patenting this, he attempted to recapture the entire old combination (cf. 298 U. S. 424). This Court refused to sanction this extension of his monopoly (298 U. S. 425). In the *Lincoln* case the same thing was attempted. There the applicable rule was stated (303 U. S. 549-550):

> "As we said of Gullborg in the *Rogers* case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function in his claimed combination. The patent is therefore void as claiming more than the applicant invented. The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination."

The analogy to the instant case is perfect. For present purposes Jungersen may be assumed to have "hit upon" an improved means of performing the wax casting step, but "he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function in his claimed combination"

3. The courts below also erred in finding invention in the use in what was called the "jewelry art" of old steps performing an old function. In effect, these courts disqualified the prior art on the theory it came from "nonanalogous casting arts" (R., p. 24a; 65 F. Supp 655). Similarly, they conceived that there was a distinct "jewelry art" and that the patent was directed to that art (R., pp. 24a-25a; 65 F. Supp. 655). These conclusions are basically wrong because there is no distinct "jewelry art" and, even if there were, the patent in suit is not restricted to it.

On the first issue the unchallenged testimony is that "Jewelry casting is just part of the casting art" (R., p. 164a; see also p. 145a).

The District Court in the *Baden* case held (69 F. Supp. 927; see also, p. 928):

> "The evidence does not justify a finding that there is a distinct jeweler's art. The only substantial evidence on the subject was that the casting of jewelry was part of the casting art."

On the second issue statements on the face of the patent foreclose any such arbitrary limitations as the Courts below read into it. The title of the patent in suit is "Method of Casting Articles of Intricate Design and a Product Thereof" (R., p. 502a). Its objects are "to facilitate the casting of small metal articles, particularly articles of intricate detail such as jewelry" (R., p. 502a, lines 1-4), and "to enable the formation of intricate castings" (R., p. 502a, lines 10-11).

The Court of Appeals in the *Baden* case made the obvious holding that

> "* * * Thus the patent refers generally to the art of casting with a reference to jewelry as an example of the use to which the method may be put. Nowhere does the distinction that plaintiff [Jungersen] now attempts to draw appear in his patent" (F. 2d , 76 U. S. P. Q. 490).

WHEREFORE, petitioners pray that this petition for rehearing of the petition for writ of certiorari be granted the cause reviewed and the judgment of the Circuit Court of Appeals for the Third Circuit with respect only to Claims 1 to 4 be reversed.

Respectfully submitted,

JOHN VAUGHAN GRONER,
EDWARD WINSOR,
Counsel for Petitioners.

New York, N. Y.
April 14, 1948.